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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,224	03/14/2001	Walter Schubert	HSS-015XX	2803

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BOSTON, MA 02109

EXAMINER

SHAHNAN SHAH, KHATOL S

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/808,224

Applicant(s)

SCHUBERT, WALTER

Examiner

Khatol S Shahnan-Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. Applicant's amendments and response to non-final action, received March 31, 2004 are acknowledged. Claims 1, 2, 4, 5, and 15 have been amended. Specification pages 1 and 16 have been amended.
2. Claims 1-15 are under consideration.

***Prior Citations of Title 35 Sections***

3. The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior office action.

***Prior Citations of References***

4. The references cited or used as prior art in support of one or more rejections in the instant office action have been previously cited and made of record. No form PTO-892 has been submitted with this office action.

***Objections Withdrawn***

5. Objection to the abstract of disclosure made in paragraph 4, of the office action mailed 10/01/03 is withdrawn in view of applicant's amendment.
6. Objection to the specification in regard to the priority statement made in paragraph 6, of the office action mailed 10/01/03 is withdrawn in view of applicant's amendment.

***Objections Maintained***

7. Objection to the specification in regard to express mail sticker made in paragraph 5, of the office action mailed 10/01/03 is maintained. Applicant's request that the examiner should withdraw the rejection has been noted. The examiner respectfully states that such request is not going to be granted because it is not proper to include a certificate of mailing

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in the first page of the specification which could lead to confusion and mistake during the issue and printing processes. See MPEP § 608.01.

***Rejections Withdrawn***

8. Rejection of claims 1-15 under 35 USC 112 second paragraph, made in paragraph 11, of the office action mailed 10/01/03 is withdrawn in view of applicant's amendment.

***Rejections Maintained***

9. Rejection of claims 1-15 under judicially created doctrine of obviousness –type double patenting, made in paragraphs 8 and 9 of the office action mailed 10/01/03 is maintained.

Applicant has not filed a terminal disclaimer to overcome these rejections.

Applicant's argue that claims 1-15 are not obvious over U.S. Patent number 6,150,173 or Application number 09/808225. Applicant further argue that step (f) of claim 1 discloses that at least one difference between the combination pattern of two different objects is determined and step (g) of claim 1 identifies at least one reagent solution whose marker pattern causes the difference determined in step (f). Applicant further argue that step (i) of claim 1 relates to a biochemical characterization of the selected molecule. In regard to Application number 09/808225 it is understood that this reference is directed in part to identifying cell specific target structures but the specificity in which this method is claimed is not taught or suggested in Application number 09/808225.

Applicant's arguments have been fully considered but they are not persuasive.

The examiner respectfully submits that claims 1-15 are obvious over U.S. Patent number 6,150,173 or Application number 09/808225. Patent number 6,150,173 teaches that at least one

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difference between the combination pattern of two different objects is determined (see column 8, lines 42-67), biochemical characterization and reagents (see columns 9 and 10).

Therefore, it would have been obvious to one of ordinary skill in the art to perform the claimed method in view of teachings of U.S. Patent number 6,150,173. In regard to Application number 09/808225 as the applicant admits the claims of both applications are drawn to a process for identifying cell specific target structures and the specificity in which this method is claimed is within the level of one ordinary skilled in the art. It is well established that optimization of variables such as specificity are within the level of ordinary skill in the art. See In re Kronig, 190 USPQ 425.

### ***Conclusion***

10. No claims are allowed.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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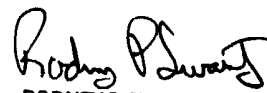
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol S Shahnan-Shah whose telephone number is (571)-272-0863. The examiner can normally be reached on 7:30am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith can be reached on (571)-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khatol Shahnan-Shah, B.S., Pharm., M.S.  
Biotechnology Patent Examiner  
Art Unit 1645  
July 6, 2004



RODNEY P SWARTZ, PH.D  
PRIMARY EXAMINER